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EXAMINER

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ART UNIT

PAPER NUMBER

2685

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BEFORE THE BOARD OF PATENT APPEALS

AND INTERFERENCES

Paper No. 22

Application Number: 09/406,001

Filing Date: 9/24/1999

Appellant(s): Aden Dale Hiatt Jr.

Dale B. Halling

For Appellant

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EXAMINER'S ANSWER

This is in response to the appeal brief filed 6-17-02.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

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(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

The rejection of claims 1-11 and 13-20 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) ClaimsAppealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

6,144,859	LaDue	11-2000
5,768,509	Gunluk	6-1998
5,742,668	Pepe et al	4-1998
Miller, Grant. "Import Personal Address Book (PAB) to Outlook 97." WWU University Residences, December 3, 1997.		

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-11 and 13-20 are rejected under 35 U.S.C. 130(a). This rejection is set forth in prior Office Action, Paper No. 15.

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(11) Response to Argument

Regarding the first issue, that is, the appellant's argument against inherency, the examiner asserts that several features of the instant invention are inherent with regards to the prior art.

First, the appellant argues in e.g. claim 1 that the "personal communication device" of claim 1 is limited to only a cellular telephone, pager or PDA, and thus the software used in the combination of Pepe and Miller (that is, Outlook '97) would not have operated on said devices at the time of the invention. However, the examiner notes first that the term "personal communication device" is a very broad term in the art, and has been for a long time. While the appellant may define such a term as he or she wishes, the examiner is not required to strictly define such a broad art term as "personal communication device" as such, unless such a definition is present in the claims. Second, the examiner notes that in the specification of the present invention, the appellants define the "personal communication device" to also include a portable computer, see invention specification page 5 lines 1-5. As such, the appellant may not exclude the portable computer taught by Pepe from being applied to the present invention.

Second, the appellant states that the method of inserting a new address book into a computer via the method taught by Miller in effect replaces the present address book, arguing that the placing of said data into the computer memory does not put the data in the address database, but rather somewhere else. However, the examiner asserts that in such a situation as taught by Miller, that is, when a file is to replace in whole another file, the memory area reserved for the address data (i.e. the "address database") would be erased and the new data entered. Since the claims do not teach or fairly suggest that the new data is somehow incorporated into the older data, as inferred by the appellant, the replacement of the first data in whole by the second data still reads on the current invention, which only recites "storing the plurality of

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addresses in the address database of the personal communication device”, see claim 1. In other words, just because the address data is wholly replaced does not mean that the “address database” is not used a second time, since the address database comprises the storage area of the personal device.

Third, the appellant states that Miller “never discusses transferring addresses between two devices”. Miller discusses receiving an address list at a user’s computer via E-mail (Inbox). The examiner is unsure how an E-mail may be sent to a computer without another computer being involved in sending said E-mail; however, even so, the sending of the E-mail from one device to another is well established by the primary reference, that is, Pepe et al. Miller is added to show that besides regular text, E-mail may be utilized to send and receive and extract address lists. The appellant states that the method of Miller is a standard method for merely saving any file to a computer, but fails to note that the data is via an E-mail sent to the user’s Inbox, and as such is not the same as merely saving a file, and inherently includes a sending computer to send said E-mail.

Third, the appellant asserts that the examiner’s use of Official Notice in regards to claim 3 has been traversed. However, the examiner has provided support for the rejection of claim 3, namely the LaDue reference, as noted in the Final Rejection, PTO paper #15. As such, the examiner asserts that proper support has been given for the rejection of claim 3. Also, while the appellant argues that a PCS system does not necessarily encapsulate a wide area network protocol, since PCS is a wide-area network protocol, it would thus “encapsulate” (i.e. consist of) a wide-area network protocol.

Fourth, the appellant states that a computer program may not necessarily contain a program for selecting and transferring the data, however, the examiner continues to assert that such a step is inherent in the combined method of Pepe in view of Miller; first, Outlook ‘97, as does any other E-mail client,

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comprises means to select and send data via E-mail, as well as means to compose E-mails to be sent. The use of software would be further inherent in the sole invention of Pepe, as only computers or computing devices operate to send and receive E-mail, and computers and computing devices inherently operate via software. That is, in order for an E-mail to be sent or received, software is an absolutely necessary portion of the link between the two devices. This software would need to select and transfer the data, or else the sending and receiving of the data would not be enabled.

Fifth, the appellant states further that the use of an address transfer program is not inherent in the combined invention of Pepe and Miller. While it is true that an address transfer program may not be necessary for all kinds of communication (e.g. voice), claim 10 specifically only teaches towards transferring address list data, which would inherently comprise the use of a program to do so, given that the two references used to render obvious the present invention use E-mail as a means to send said data. Further, while the appellant states that the assumption of data by the examiner, that is, that the E-mail should be able to take any reasonable form based on the needs of the user, is incorrect since the purpose of the present invention is to aid in sending address data; however, as shown by Miller, there was a notoriously well-known E-mail client which offered such a service prior to application by the appellant, which offered flexibility in the use of the software. That is, a user at the time of the invention had a multitude of options for E-mail, including attachments, plain text, etc. Besides, the statement of assumption by the examiner regarding the kind of data used is not without support, in the form of the teachings of Miller, which shows that indeed a user may receive a complex address book via E-mail as well. That is to say, the aforementioned statement that the user may utilize E-mail to send and receive any number of different kinds of messages is not the only support that such a limitation is obvious.

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Sixth, given that the combined invention of Pepe in view of Miller creates a portable laptop computer running Outlook '97 (via a GUI such as Windows), the selection of a file (for example, the PAB of Miller) would have been obvious in order to allow the entire file to be sent via the method of Miller. As is used in Outlook, the selection of a field of the file (for example, the title or name of the file) is used in the sending of the file (note that Miller teaches that the PAB file has a name). As such, the examiner continues to assert that the selection of a file and a filename would be obvious, if not inherent in an E-mail client such as Outlook '97, especially given that claims 13 and 14 do not state that the selection is done specifically by hand, by a user; regarding claim 13, the selection of a file, even if a user is not involved in the sending of the address list file, would inherently involve a selection of the file to be sent.

Seventh, the appellant states that, regarding claim 18, the use of "transfer software", stated above, is not the same as "address transfer software". However, given that in the combined invention of Pepe in view of Miller, the inherent software would be transferring addresses- this means that the software would be "address transfer software". While the specification may define "address transfer software" as that which aids the user in transferring addresses, the software used by Pepe in view of Miller (Outlook) also aids the user in transferring data including a PAB file. This is why the method of Miller is short, because Outlook aids the user in importing and installing the address list. As stated above, the use of a program such as Outlook which provides users with a transfer option is established in the combination of references. While it is true that transferring data from one system to another and keeping the data in usable form is difficult, the disclosure of Pepe delves deeply into solutions to such problems, noting various kinds and types of data, and translations between them specifically for the purpose of keeping the integrity of e.g. an E-mail which is sent from one computer to another over a combined wired-wireless link. As such, this step

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is not “brushed under the rug”, as insinuated by the appellant. Since Pepe discloses that an E-mail may be sent over the entire network and retain its proper form, and Miller discloses that an address book may be wrapped up in an E-mail, there is no reason why one of ordinary skill in the art, if not one of less-than ordinary skill in the art, would not have been able to operate the combined invention of Pepe in view of Miller to send an address list via E-mail.

Regarding the second issue, that is, the appellant’s argument that the Microsoft Publications (Q162203 and Q169709) are not prior art.

As the examiner has explained previously (see for example the Final Office action and Advisory Action, PTO Papers #15 and 17, respectively) the Microsoft publications listed above are not used as prior art, but rather as an aid in further understanding the process by which a PAB file may be received via E-mail. Given that said feature was available in Outlook ‘97, and the process is shown by Miller before application by the appellant, the publications are used as an aid to the reader in case he or she wishes to read more, and is not intended to be a part of the combination of Pepe and Miller. This is why the examiner made note of the publications after the prima facie case of obviousness had been established.

Regarding the third issue, that is, the appellant’s argument against the Miller reference.

First, while the appellant continues to argue the lack of concatenation of data using Outlook, the examiner notes, as stated above, that the claims do not exclude the complete replacement of the address book. The examiner continues to assert that in such a situation as taught by Miller, that is, when a file is to replace in whole another file, the memory area reserved for the address data (i.e. the “address database”) would be erased and the new data entered. Since the claims do not teach or fairly suggest that the new data is somehow incorporated into the older data, as inferred by the appellant, the replacement of the first

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data in whole by the second data still reads on the current invention, which only recites “storing the plurality of addresses in the address database of the personal communication device”, see claim 1. In other words, just because the address data is wholly replaced does not mean that the “address database” is not used a second time, since the address database comprises the storage area of the personal device.

Second, the appellant continues to argue that in e.g. claim 1 that the “personal communication device” of claim 1 is limited to only a cellular telephone, pager or PDA, and thus the software used in the combination of Pepe and Miller (that is, Outlook ‘97) would not have operated on said devices at the time of the invention. However, the examiner notes again that not only is the examiner is not required to strictly define such a broad art term as “personal communication device” unless such a definition is present in the claims, but further, in the specification of the present invention, the appellants define the “personal communication device” to also include a portable computer, see invention specification page 5 lines 1-5. As such, the appellant may not exclude the portable computer taught by Pepe from being applied to the present invention, and the argument against the method of Miller being utilized in a “personal communication device” is rendered moot.

Regarding the fourth issue, that is, the appellant’s argument regarding Pepe in view of Miller.

The examiner continues to support the combination of Pepe and Miller, and the inherency of several limitations, as supported above. Regarding the use of Official Notice, the examiner notes above that support was provided, evidence which the appellant continues to ignore. Regarding the other art of record (Microsoft publications), see above regarding the second issue. Regarding the Miller reference and the address database, see above regarding the third issue. Lastly, regarding the use of Outlook in a personal device, see above regarding the fourth issue.

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Regarding the fifth issue, that is, the appellant's argument regarding Pepe in view of Miller and Gunluk.

The appellant's arguments regarding said combination are based on the previous arguments stating that the combined invention of Pepe in view of Miller would not operate on a personal communication device as defined by the appellant. However, as noted above, the appellant is attempting to use a different definition of "personal communication device" than that which is defined in the specification in order to traverse the examiner's rejection. Given that such an argument is not valid, they are rendered moot by the appellant's own definition, as stated and supported above regarding the first and fourth issues.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Charles R Craver

CHARLES CRAVER
PATENT EXAMINER

cc

December 6, 2001

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